

### REMARKS

This is responsive to the Office Action mailed January 4, 2007. At the time of the Office Action, Claims 1-33 were pending in this Application. Claims 1-33 were rejected. Claims 1 and 23 have been amended to further define various features of Applicant's invention. The amendment is supported in the application at, for example, page 2, lines 17-25 as well as originally filed claims 7 and 9. Additionally, claims 7 and 9 have been cancelled. New claims 34, 35 have been added and are supported in the application at, e.g., pages 1-3. Based on the remarks and amendments herein, Applicant respectfully requests reconsideration and favorable action in this case.

#### Rejections under 35 U.S.C. § 102

According to the Office Action, Claims 1-6, 12-14, 23 and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,946,467 to Ohi et al. ("Ohi").

Applicant requests reconsideration and withdrawal of the rejection of the claims under Section 102 in view of the amendment to the claims and the remarks below.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). In the instant case, not all claim limitations are found in Ohi.

In particular, Claim 1 has been amended by collapsing Claim 7 and Claim 9 into Claim 1. Applicant notes that Claim 7 and Claim 9 contain additional claim limitations and were not rejected in the Office Action under Section 102. Consequently, the Section 102 rejection is mooted with respect to Claim 1 and the claims that depend therefrom.

Independent Claim 23 has also been amended and recites a claim limitation that is not disclosed in Ohi. In particular, Claim 23 recites that, in addition to the first and second materials being different, the second material is a material having good knot-tying ability and the first material is a material having high tenacity. Ohi does not disclose this combination of first and second materials.

The other claims rejected under Section 102 depend from either Claim 1 or Claim 23 and accordingly are also not anticipated by Ohi for the same reasons that Claim 1 or Claim 23 are not anticipated by Ohi.

Based on the foregoing, reconsideration and withdrawal of the rejection under Section 102 is requested.

### **Rejections under 35 U.S.C. §103**

According to the Office Action Claims 7-11, 20-22 and 25-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ohi in view of U.S. Patent No. 6,045,571 to Hill et al. ("Hill").

Applicant submits that, in view of the amendments made to the claims as described above, a *prima facie* case of obviousness is not properly made. A *prima facie* case of obviousness requires, amongst other things, that the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j). In the instant case, not all claim limitations are taught or suggested by any combination of Ohi and Hill.

In particular, no combination of Ohi and Hill teach or suggest (A.) a suture comprising a material wherein the *first material is a high molecular weight, high tenacity material*, and a cover surrounding the core, the cover including a plurality of cover fibers made of a second material *different* than the first material, and wherein the *second material is a polymeric material selected from the group consisting of PET, polyester, coated urethanes, and mixtures thereof*, or (B.) a core including a plurality of core fibers consisting solely of a first high strength material, and a cover surrounding the core, the cover including a plurality of cover fibers consisting solely of a second material different than the first material and wherein the *second material is a material having good knot-tying ability* and wherein the *first material is a material having high tenacity and a greater tensile strength than said second material* as recited in Claim 1 and Claim 23 respectively. The cited references do not teach or suggest these claim limitations.

Though Hill states that the "[t]sheath and core may be made of the same or different yarns", Hill does not suggest the specific combination that is recited in the pending claims. Additionally, the wide variety of materials disclosed in Hill introduces uncertainty as to which materials work together or whether one material works better with one material than another.

Hill, in some sense, addresses a different problem than that of the instant application. Namely, Hill addresses core "pop-out" by varying the pick counts. In contrast, the present invention provides a different advantage. The present invention is directed to providing a suture with improved knot-tying characteristics and high inner core strength. Claim 23, for example, recites a suture comprising, amongst other things, an outer cover having enhanced knot-tying characteristics such as a *high coefficient of friction* in combination with a *high tenacity core*. These are characteristics and claim limitations that are not suggested by Hill nor is it clear that a high tenacity inner core member is desirable in Hill because a high tenacity core may, in fact, facilitate core pop-out. Indeed, a core with increased strength may be more likely to pop out, an opposite result to that desired in Hill.

Given the specific claim limitations recited in Claim 1 and Claim 23 and the absence of any teaching or suggestion to provide the specific combination of elements, Applicant submits the subject matter of Claim 1 and Claim 23 is patentable over Ohi, Hill or any combination of the two references.

The other claims rejected under Section 103 depend from either Claim 1 or Claim 23 and consequently are patentable over the cited references for at least the same reasons that Claim 1 and Claim 23 are patentable.

Based on the foregoing, reconsideration and withdrawal of the rejections of all the claims is requested.

**CONCLUSION**

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 408.735.6323. Also, the Commissioner is hereby authorized to charge any fees necessary to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

Respectfully submitted,



Richard R. Batt  
Reg. No. 43,485

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ArthroCare Corporation  
680 Vaqueros Avenue  
Sunnyvale, California 94085-3523  
408.735.6323 | phone  
408.530.9143 | fax  
CUSTOMER NO. 21394